

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 19-21, 23-32 and 39-44 are pending in the application, with claim 19 being the sole independent claim. Claims 1-18, 22 and 33-38 were cancelled in previously filed replies. New claim 44 is sought to be added. Claims 19, 42 and 43 have been amended to clarify the claims. These changes are believed to introduce no new matter, and their entry is respectfully requested.

The Examiner is asked to enter and consider this reply after final because it raises no new issues requiring further search and/or consideration and places the application in condition for allowance and/or better condition for appeal.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Rejections under 35 U.S.C. § 103***

**Claims 19-21, 23-29, 31, 32 and 39-43**

Claims 19-21, 23-29, 31, 32 and 39-43 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,637,110 to Pennybacker *et al.* (hereafter "*Pennybacker*") in view of U.S. Patent No. 5,827,281 to Levin (hereafter "*Levin*"). *Office Action*, pp. 2-6. Applicants respectfully traverse this rejection, and the Response to Arguments on pages 7-8 of the Office Action.

Independent claim 19 recites, among other things:

the first blade member comprising a first blade member  
shearing edge extending to a distal end of the first blade member and the

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second blade member comprising a second blade member shearing edge extending to a distal end of the second blade member;

the first blade member comprising a first blade member distal portion, the second blade member comprising a second blade member distal portion, wherein at least one of the distal portions further comprises a bulbous portion protruding from the blade member, the bulbous portion being on an exterior side of the blade member proximally adjacent the distal end of the blade member, and the bulbous portion having an exposed electrically-conductive surface.

In the pending Office Action, the Examiner appears to concede that *Levin's* tips (30A and 30B) cannot be interpreted to be "bulbous portions." *Office Action*, p. 7. However, the Examiner now asserts that "the rounded top portion of jaw 22A and the round bottom portion of the jaw 22B as shown in figures 4 and 6" can now satisfy the "bulbous portions" feature. *Id.*, p. 8. Applicants respectfully disagree.

However, without conceding the above assertion and solely to expedite prosecution, Applicants have amended independent claim 19 to recite "the bulbous portion having an exposed electrically-conductive surface". As the instant specification notes, for example:

"the exterior side surfaces 137, 139 of blade members 34, 36 include a covering 156 of electrically insulating material, ..., except for the surface 152 of bulbous portion 154. ... While exterior bulbous portion 154 is configured to coagulate tissue ... ." *Published specification, U.S. Patent Application Publication No. 2006/0235379, paras. [0067], [0068].*

*Levin* does not disclose the above distinguishing feature of "the bulbous portion having an exposed electrically-conductive surface". In fact, the Examiner appears to acknowledge the fact that *Levin* does not disclose "an **exposed** electrically conductive surface," by stating that "Levine [sic] discloses ... an electrically conductive spherical

surface (electrically conductive surface of each bulbous portion of the jaws 22A, 22B which are covered by the insulating layer 27." *Office Action*, p. 3.

Based on the above analysis, *Levin* fails to disclose the feature of "the bulbous portion having an exposed electrically-conductive surface," as recited in independent claim 19. Moreover, the Examiner does not assert that *Pennybacker* discloses, nor does *Pennybacker* disclose, the above recited feature. Absent this disclosure in *Pennybacker* or *Levin*, and therefore in the asserted *Pennybacker-Levin* combination, claim 19 is therefore not rendered obvious and therefore Applicants respectfully request that the rejection be withdrawn.

Dependent claims 20, 21, 23-29, 31, 32 and 39-43 are patentable for at least the same reasons as independent claim 19 from which they directly or indirectly depend, and further in view of their own respective features.

### **Claim 30**

Claim 30 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Pennybacker*, in view of *Levin*, and in further view of U.S. Patent No. 5,352,222 to Rydell (hereafter "*Rydell*"). *Office Action*, pp. 6-7. Applicants respectfully traverse this rejection.

The rejection to claim 19, from which claim 30 depends, was traversed above based on the lack of disclosure of *Pennybacker* and *Levin* regarding features recited in claim 19. Even assuming *arguendo* that *Pennybacker*, *Levin*, and *Rydell* may be combined in the manner asserted by the Examiner (which Applicants do not concede), *Rydell* does not remedy the above deficiency of *Pennybacker* and *Levin*. Nowhere does

*Rydell* disclose, nor does the Examiner assert that *Rydell* discloses, for example, "the bulbous portion having an exposed electrically-conductive surface," as recited in claim 19. Consequently, *Pennybacker*, *Levin* and *Rydell*, either alone or in combination, does not render obvious independent claim 19 or dependent claim 30. Applicants respectfully request that the rejection of claim 30 be withdrawn.

***New Claim 44***

New claim 44 is dependent upon independent claim 19. Applicants assert that claim 44 is patentable for at least the same reasons as independent claim 19 from which it depends and further in view of its respective features. Support for new claim 44 may be found in the original disclosure, e.g. at page 16, lines 28-36 in the specification.

Applicants respectfully request entry and allowance of this newly presented claim 44.

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MCCLURKEN *et al.*  
Appl. No. 10/532,704

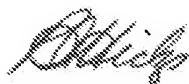
***Conclusion***

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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